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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,268

02/26/2004

Bradley R. Stager

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EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

03/26/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/789,268	<b>Applicant(s)</b> STAGER, BRADLEY R.	
	<b>Examiner</b> Bena Miller	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9,20,21 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,20,21,30-35 and 37-44 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

**The remarks in the RCE filed 07/15/09 are duly noted.**

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9, 20, 21 and 30-44 are finally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 6,757,052 in view of Bielagus et al (US Patent 5,937,923) or Smith (US Patent 6,662,837).

The claims of the instant application recite most of the elements of the patented claims except for a wearshoe. Bielagus teaches a rotary cutter blade clamp having a wearshoe for mounting a knife 114. Smith teaches a wood chipper including a wearshoe 2a for mounting a knife. It would have been obvious to one of ordinary skill in the art to

incorporate a wearshoe as suggested by Bielagus or Smith for the reasons set forth above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 20 and 21 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US Patent 6,662,837).

The device of Smith teaches the elements of the claimed invention. Smith teaches a knife assembly including a knife 23 clamped via a bolt 25 between an upper clamp surface 13 and wear shoe 2a. The upper clamp surface 13 and wear shoe 2a has a cooperatively interlocking portion between clamp plate flange 11 and base channel 4. Smith further teaches cooperatively ramping portions that are sloped relative to and axis as seen figure 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3725

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

In the event disagrees with the rejection above, it would have been obvious to one of ordinary skill in art at the time the invention was made to cooperatively ramping portion for the purpose of firmly secure the knife.

Claims 30-34 and 37-42 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to have the interlocking portions of the wear shoe and base of Smith to define an angle with respect to the first direction in the range 45-60. degrees and cooperatively ramping portions define an angle about 5 degrees for the purpose of firmly holding the knife in place with a minimum amount of applied force.

Claim 9 and 44 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nettles (US Patent 5,348,064) in view of Schneider (US Patent 5,983,769) or Gotham (US Patent 4,000,460).

Nettles teach most of elements of the claimed limitations including a ring assembly comprising two end plates for rotation about an axis of rotation (fig.1);; and a plurality of knife assemblies (fig. 2), each assembly comprising an elongate knife having a cutting edge extending along an elongate axis (fig.2), a clamp for clamping the knife (1.1), and a base (1.2) for supporting at least a portion of said clamp, said assemblies for installation between said end plates such that the shoulder portions of said at least

two shoulder bolts extend through one of said end plates into said base (fig.3). Nettles further teach that the upper clamp portion cantilevers over the wearshoe (fig. 4, col. 5, par. 2). However, Nettles does not teach a threaded shoulder bolt. Schneider or Gotham teaches that it is well known in the art to use a threaded bolt for securing a knife to a cutting device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the bolt of Nettles for the threaded bolt of Schneider or Gotham for the purpose of securing the knife to the device.

Claim 35 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

Smith teaches most of the elements of the claimed invention except for the claimed angle range for the interlocking portions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to define an inclined angle for the interlocking portions of Smith between the claimed range, since it has been held that where the general conditions of a claim disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Allen, 105 USPQ 233.

Claim 43 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Nettles.

Smith teaches most of the elements of the claimed invention except for the upper clamping member extends cantilevered over a portion of the wear shoe. Nettles solve this problem by disclosing a similar apparatus including an upper clamp portion that cantilevers over the wearshoe (fig. 4, col. 5, par. 2). Therefore, it would have been

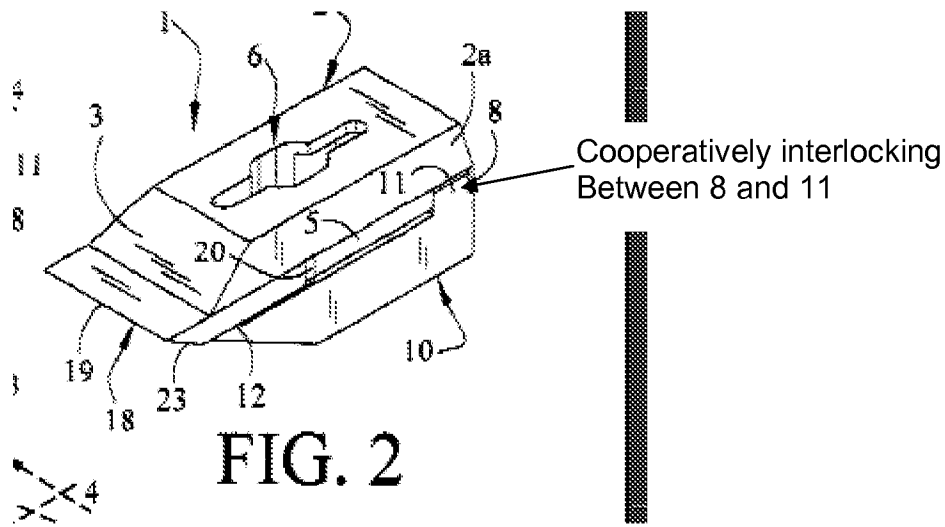
obvious to one of ordinary skill in the art to modify the device of Smith to include the above claimed features, as suggested by Nettles, for the purpose of avoiding strain to the blade when cutting material.

***Allowable Subject Matter***

Claim 36 is finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 12/24/09 have been fully considered but they are not persuasive. The applicant traverses the Double Patenting. The applicant argues the prior fails to teach shoulder bolts. The examiner disagrees. Bielagus et al or Smith clearly shows a shoulder bolt (118 or 25, respectively). The applicant further argues the prior art fails to teach the limitations of claims 20 and 21 as noted in paragraphs 1 and 2 of page 11 of the Remarks. It should be noted that Bielagus teaches a ramping portion as seen in Figure 8. The examiner takes the position that either one of the prior teach the claimed limitations as shown in the marked copy figure noted below:



**FIG. 2**

Figure 2 of Smith

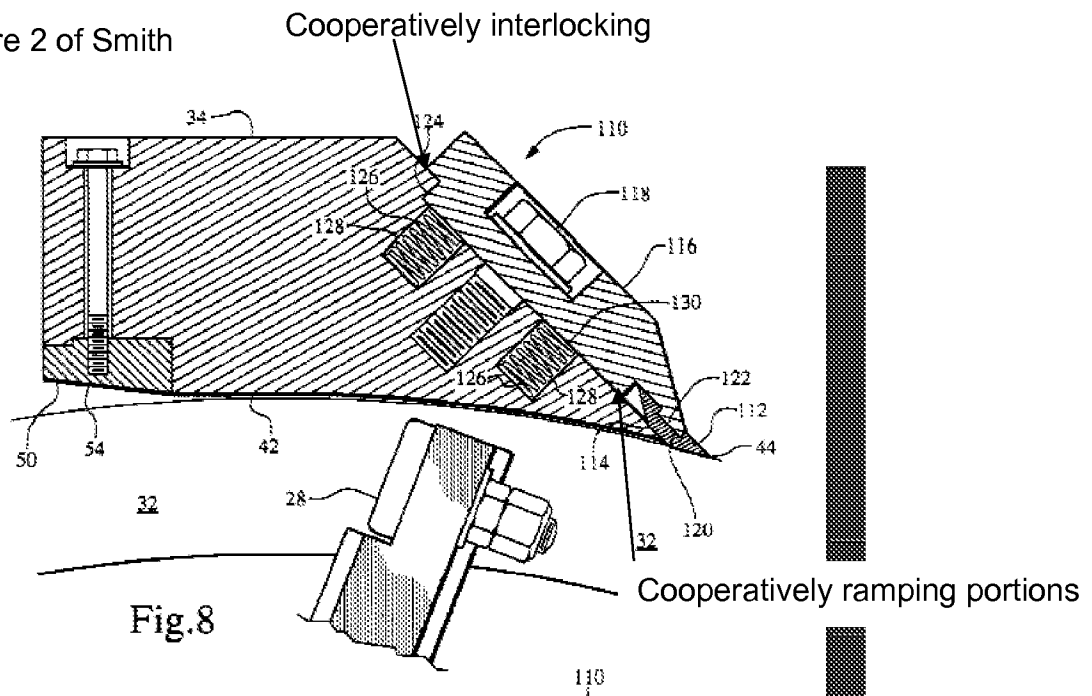


Figure 8 of Bielagus et al

The applicant's second argument is Smith fails to teach all of the limitations of claims 20 and 21. The applicant disagrees that the blade mount base 2 is a wearshoe. The examiner disagrees and contends that the blade mount base functions as a wearshoe for the device. The applicant further argues the prior art fails to teach three



separate components: a wearshoe, a base and an upper clamping member. The examiner contends the prior art clearly teaches the elements: a wearshoe (2a), an upper clamping member (13) and a base, as broadly recited, element 35. In response to the applicant's remaining arguments on page 12 of the Remarks, the applicant's attention is directed to the above marked copy figure.

The applicant argues on page 13 of the Remarks that Loth does not teach the wearshoe and base interlocking as required by the claim. The examiner has withdrawn the rejection; therefore, the argument is moot.

In response to the applicant's argument that adding cooperatively ramping portions to Smith, for the reasons set forth above, is mere assertion, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It should be noted, Smith teaches in column 2, lines 32 through 37 that the blade body can be **secured** in place between the blade mount base and clamp plate, in this instance, further supporting the motivation provided by the examiner, noted by the applicant in paragraph 2 of page 13 of the Remarks.

In response to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 3725

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schneider and Gotham teaches a threaded shoulder bolt in Figures 7 and 4, respectively. It should be noted the claim, claim 9, requires each shoulder bolts having a threaded portion. Therefore, it would have been obvious to combine either one of the prior art with Nettles to meet the claimed invention.

In response to the applicant's argument to claim 25, the examiner inadvertently indicated a rejection to the integral structure rather than the optimum ranges. The applicant's attention is directed to the above rejection.

For the reasons set forth above, the Office Action is made Final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bena Miller/  
Primary Examiner, Art Unit 3725  
March 24, 2010